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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/882,174      | 06/14/2001  | William Kress Bodin  | AUS920010463US1     | 8001             |

34533 7590 05/19/2005

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EXAMINER

PATEL, HARESH N

ART UNIT PAPER NUMBER

2154

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/882,174

Applicant(s)

BODIN ET AL.

Examiner

Haresh Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-66 are presented for examination.

#### ***Response to Arguments***

2. Applicant's arguments filed 12/17/04 have been fully considered but they are not persuasive. Therefore, rejection of claims 1-66 is maintained.

Applicant argues, (1) "cited references, i.e., Application Server Solution Guide, Enterprise Edition: Getting Started, Nusbaum, May 2000, Nusbaum et. al., pages 1-45, 416-434 (Hereinafter Nusbaum), Java Media Framework API Guide, JMP 2.0 FCS, November 19, 1999, Sun Microsystems, page 1-66, 109- 135, 173-178 (Hereinafter Sun1), JavaMail API Design Specification, Version 1.1, Sun Microsystems, August 1998, pages 1-21, 41-50, 55-60 (Hereinafter Sun2), are improperly combined. The examiner respectfully disagrees in response to applicant's arguments. The cited references, Nusbaum, Sun1 and Sun2 teach a method, a system, a computer software product for email administration, all what the applicant is trying to accomplish, as per the claimed invention. Nusbaum discloses use of a transcoding gateway/server for software administration (e.g., figure 8, page 8). Sun1 discloses well-known concept of transcoding (e.g., pages 4, 6 and 33). Sun2 discloses handling of e-mail messages (e.g., page 1). All cited references support the claimed method, a system and a computer software product. Also, The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of a primary reference. It is also not that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinally

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skill in the art. In re Keller, 642 F.2d 414, 425, 208 USPQ 871, 881 (CCPA 1981); In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). Therefore, the rejection is maintained.

Applicant argues, (2) "cited references, i.e., Nusbaum, Sun1, Sun2, does not contain a suggestion, or motivation to modify or to combine with each other. The examiner respectfully disagrees in response to applicant's arguments. In response to the references containing a suggestion, or motivation to modify or to combine with each other, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of a primary reference. It is also not that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 414, 425, 208 USPQ 871, 881 (CCPA 1981); In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). Nusbaum discloses usage of a gateway/server for software administration (e.g., figure 8, page 8). Sun1 discloses the well-known concept of transforming of the digital objects and using the digital formats for streaming digital objects. The teachings of the Nusbaum gateway/server would support transform / transcode information of the objects/information that are taught by Sun1. Sun2 discloses well-known concept of different fields of e-mail message that provide different information, including source and destination addresses, file names, file path information, data location information, format information. The teachings of the Nusbaum gateway/server would support handling of e-mail message contents that are taught by Sun2. Therefore, the rejection is maintained.

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Applicant argues, (3) “cited references, i.e., Nusbaum, Sun1, Sun2, does not contain a suggestion of any expectation of success”. The examiner respectfully disagrees in response to applicant's arguments. In response to the references containing a suggestion of any expectation of success, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of a primary reference. It is also not that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 414, 425, 208 USPQ 871, 881 (CCPA 1981); In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). The claimed subject matter accomplishes a method, a system, a computer software product for email administration. Nusbaum discloses usage of a gateway/server for software administration (e.g., figure 8, page 8). Sun1 discloses the well-known concept of transforming of the digital objects and using the digital formats for streaming digital objects. Sun2 discloses well-known concept of different fields of e-mail message that provide different information, including source and destination addresses, files names, file path information, data location information, format information. The combined teachings of Nusbaum, Sun1 and Sun2 would support implementing all claimed limitations to accomplish a method, a system, a computer software product for email administration, as claimed. Therefore, the rejection is maintained.

Applicant argues, (4) “cited reference, i.e., Nusbaum, teaches away from the claims of the present application and it is a nonanalogous art”. The examiner respectfully disagrees in response to applicant's arguments. In response to applicant's argument that Nusbaum is nonanalogous art, it has been held that a prior art reference must either be in the field of

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applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, a system for email administration, as claimed, is similar to Nusbaum's teachings of computer device, i.e., gateway/server for software administration usage (e.g., figure 8, page 8), which is the same field of endeavor. The well-known software to support handling of e-mail message contents that are taught by Sun2 would be supported by Nusbaum. Therefore, the rejection is maintained.

Applicant argues, (4) "cited reference, Sun2 does not disclose limitations, receiving an email message, the email message having destination mailbox address and object, and the e-mail information having mailbox address field, a mailbox address identical to the destination mailbox address of the email message, an internet address field, a file format code field, and a path name field. The examiner respectfully disagrees in response to applicant's arguments. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Sun2 discloses limitations, receiving an email message (e.g., use of JavaMail API to receive message, lines 1-4, figure 3-1, page 6), the email message having destination mailbox address and object (e.g., page 10, lines 8 – 38), and the e-mail information having mailbox address field (e.g., pages 54, 57), a mailbox address identical to the destination mailbox address of the email message (e.g. pages 54 and 57), an internet address field (e.g., pages 54 and 57, a file format code field (e.g., figures 54 and 57), and a path name field (e.g.,

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pages 20, 60). Also, page 18, lines 9-13 of the specification, clearly states, "It will be understood from the foregoing description that various modifications and changes may be made in the preferred embodiment of the present invention without departing from its true spirit. It is intended that this description is for purposes of illustration only and should not be construed in a limiting sense. The scope of this invention should be limited only by the language of the following claims". Since, applicant's claims contain broadly claimed subject matter, it clearly reads upon the examiner's interpretation of the claimed subject matter. Therefore, the rejection is maintained.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-10, 13, 15-18, 23-32, 35, 37-40, 45-54, 57, 59-62, are rejected under 35 U.S.C. 103(a) as being unpatentable over Application Server Solution Guide, Enterprise Edition: Getting Started, Nusbaum, May 2000, Nusbaum et. al., pages 1-45, 416-434 (Hereinafter Nusbaum) in view of Java Media Framework API Guide, JMP 2.0 FCS, November 19, 1999, Sun Microsystems, page 1-66, 109- 135, 173-178 (Hereinafter Sun1) in further view of JavaMail API Design Specification, Version 1.1, Sun Microsystems, August 1998, pages 1-21, 41-50, 55-60 (Hereinafter Sun2), as per non-final office action, dated 9/24/2004.

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5. Claims 11, 12, 14, 33, 34, 36, 55, 56, 58, are rejected under 35 U.S.C. 103(a) as being unpatentable over, Nusbaum in view of Sun1 and Sun2 and in further view of Carter et al, "Method and apparatus for automatic conversions for electronic mail to an internet web site", US 2002/0105545 A1, August 8, 2002 (Hereinafter Carter), as per non-final office action, dated 9/24/2004.

6. Claims 19, 41, 63, are rejected under 35 U.S.C. 103(a) as being unpatentable over, Nusbaum in view of Sun1 and Sun2 and in further view of Wenocur et al, US 2003/0009694, A1, Jan., 9, 2003 (Hereinafter Wenocur), as per non-final office action, dated 9/24/2004.

7. Claims 20-22, 42-44, 64-66, are rejected under 35 U.S.C. 103(a) as being unpatentable over, Nusbaum in view of Sun1 and Sun2 and in further view of Killcommons et al, 6,424,996 (Hereinafter Killcommons), as per non-final office action, dated 9/24/2004.

### ***Conclusion***

8. The prior art made of record (forms PTO-892 and applicant provided IDS cited arts) and not relied upon is considered pertinent to applicant's disclosure.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37



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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is (571) 272-3973. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Haresh Patel

May 12, 2005

 **JOHN FOLLANSBEE**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**